

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-16, 18, and 20-24 are pending in this application. Claims 1-10 and 22 have been withdrawn from consideration.

The outstanding Office Action includes a rejection of Claims 11, 18, 20, 21, 23, and 24 under the second paragraph of 35 U.S.C. §112, an improper (lacking a clear statement of the statutory grounds of rejection) rejection of Claims 12-16 as being indefinite, a rejection of Claim 11-13, 16, 18, 20-21, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Orita et al. (U.S. Patent No. 5,003,616, Orita) in view of Lanier (U.S. Patent No. 6,400,374), and a rejection of Claims 14 and 15 as being unpatentable over Orita in view of Lanier and in further view of JP 4-205476.

REQUEST FOR WITHDRAWAL OF INCOMPLETE ACTION

The outstanding Action is incomplete in failing to list Claims 1-10 and 22 as pending but withdrawn from consideration in the Office Action Summary or elsewhere. This failure to acknowledge Claims 1-10 and 22 as being pending claims was called to the attention of the PTO at page 12 of the response filed February 19, 2004, but remains uncorrected. As Claims 1-10 and 22 have still not been mentioned in any manner in the outstanding Action, the MPEP §707.07(i) requirement that each pending claim is to be mentioned by number in each Action has been violated and the present incomplete Action should be withdrawn for this reason alone.

The outstanding Action is further incomplete and should be withdrawn because it fails to positively set forth the statutory grounds relied upon to reject Claims 12-16. See the requirement of MPEP §707.07(d) that the ground of any rejection must be "fully and clearly stated." As this has not been done in the

outstanding Action, withdrawal of this incomplete Action is again mandated by the MPEP.

Furthermore, MPEP §707.07(f) requires that arguments made in a previous response must be answered when repeating a rejection. In this regard, the response filed February 19, 2004, noted that:

With regard to independent Claims 18, 21, and 24, it is noted that each of these claims recite and require judging if a display apparatus is in a specific operating condition or not and a specific image is displayed when the display apparatus is in the specific operating condition. The specific operating condition includes at least one of a state in which no image signal is being given to the projection display apparatus and a state in which a prescribed period has not elapsed after the startup of the projection display apparatus. As noted above, the language that “a state in which a prescribed period has not elapsed after the startup of the projection display apparatus” means that, for example, the display apparatus has not yet reached a stable state as described at page 43, line 3 through page 45, line 8 of the specification. Neither Orita and/or Lanier reasonably teach or suggest these features of independent Claims 18, 21, or 24 whether they are considered alone or together in any proper reference combination. Thus, this rejection of independent Claims 18, 21, and 24 is traversed.

Instead of explaining how Lanier teaches judging and detecting the claimed specific operating condition, page 5 of the outstanding Action erroneously suggests (with reference to similar limitations in Claim 16) that the Lanier superimposing of video images, one from camera 2 and one from a separate source such as a computer generated image, can somehow be interpreted as the claimed judging and detecting. This lack of explanation not only conflicts with the requirements of MPEP §707.07(f), it also conflicts with the requirement of 37 CFR §1.104(c)(2) for a clear explanation as well as established precedent. See In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”). Accordingly, this failure to explain where and how Lanier

teaches judging and detecting the claimed specific operating condition also mandates that the outstanding incomplete Action be withdrawn.

REQUEST FOR RECONSIDERATION UNDER 37 CFR §1.116

Page 2 of the outstanding Action rejects Claim 11, 18, 20, 21, 23, and 24 under the second paragraph of 35 U.S.C. §112, asserting that the language of the independent Claims 11, 20, and 23 as to "... a state in which a prescribed period has not elapsed ..." (emphasis added) is impossible because "if any given apparatus starts, regardless of how minimal, time will elapse."

However, the questioned language cannot be reasonably interpreted as stating that "no time" period will elapse after device startup as the PTO appears to have interpreted it. Instead, this questioned language requires that a specific amount of time (defined as the "prescribed period") will not have "elapsed" after the startup of the projection display apparatus.

MPEP §2173.02 notes that the essential inquiry as to claim compliance with the second paragraph of 35 U.S.C. §112 is never made in a vacuum. Rather, this inquiry must be made in light of the content of the particular application and how it would be interpreted by one of ordinary skill in the art. In other words, "[t]he test for definiteness under 35 U.S.C. §112, second paragraph, is whether 'those skilled in the art would understand what is claimed when read in light of the specification.'

*Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)."

In this last regard, page 44, lines 3-15, for example, describe an operating condition judging signal SPMODE that is low when the system is in the specific image display mode during the prescribed time period illustrated as T2 in Fig. 30 (b).

This SPMODE signal of Fig. 30 (e) is low until the expiration of the prescribed period T2 (i.e., prior to the elapse of prescribed time period T2) permitting a specific image display while this SPMODE signal is low. When the prescribed period T2 has elapsed, the SPMODE signal of Fig. 30 (e) goes high to permit an input image display and cut off the specific image display. Further, the specific image can be displayed when it is detected that there is no input image signal. Thus, when the lack of any input image signal is detected, the SPMODE signal of Fig. 30 (e) again goes low to permit another specific image display. See the specification at page 44, lines 16-23 and Figs. 30 (c) and 30 (e), for example.

As the meaning of the amended claim language “a state in which a prescribed <sup>117</sup> period has not elapsed after the startup of the projection display apparatus” would, therefore, be clear to the artisan when considered in light of the disclosure, this outstanding rejection of Claims 11, 18, 20, 21, 23, and 24 under the second paragraph of 35 U.S.C. §112 should be withdrawn.

To the extent that the rejection of Claims 12-16 as being indefinite was intended to be based upon the second paragraph of 35 U.S.C. §112 because these claims include the above-noted limitation as to the “prescribed period” by virtue of claim dependency, this rejection is traversed for the above-noted reasons and should also be withdrawn.

Turning to the outstanding rejection of Claims 11-13, 16, 18, 20, 21, 23, and 24 as being unpatentable over Oritain view of Lanier, it is noted that independent Claims 11, 20, and 23 all require an extraction image to be extracted from a given target image with the specific image including the extraction image display being controlled by the specific image display control section. This specific image display is further limited by these independent claims so that it can occur only when the

claimed specific operating condition is established, which claimed specific operating condition includes at least one of a state in which no image signal is being given to the projection display apparatus and a state in which a prescribed period has not elapsed after the startup of the projection display apparatus.

The outstanding Action acknowledges that Orita does not teach or suggest these and other features of independent Claims 11, 20, or 23, but suggests that the Lanier superimposing of a real time image from camera 2 with a separate source image, such as a computer generated graphics image, can be said to reasonably teach these claimed features missing from Orita. ✕

In this regard, page 4 of the outstanding Action specifically relies upon Lanier as teaching the video camera 2 and its Figure 1 illustrated lens as some how being an electro-optical device to form images responsive to image display signals. However, it is universally understood that video cameras capture images and convert the image captured into a video signal for transmittal to a video display device that converts the video signal into a displayed image on a display screen thereof. Thus, the video camera 2 and its Figure 1 illustrated lens clearly form image display signals, not the asserted "images responsive to image display signals." ✕

The outstanding Action next assumes that the video display 4 of Figure 1 of Lanier can be somehow characterized as the claimed projection optical system for projecting light emitted by the electro-optical device. However, as discussed above, a video camera provides a video signal that can be transmitted to a video display to be converted by the display to a screen image. The camera 2 cannot be reasonably read as emitting light that is then projected by the display 4 as urged in the outstanding Action. ✕

The outstanding Action then misinterprets the display 4 as somehow being or including the claimed “specific image display control section” that will provide a display of “a specific image represented by specific image data including the extraction image data stored in the extraction image memory.” However, as noted above, display 4 simply receives a video signal and converts it to a display image on a display screen thereof. Nothing in Lanier suggests that display 4 displays its superposed images based on a specific projection display apparatus operating condition like the claimed ones including at least one of a state in which no image signal is being given to the projection display apparatus and a state in which a prescribed period has not elapsed after the startup of the projection display apparatus. ✕

In this last respect, if the camera 2 of Lanier captures no image as suggested by page 4 of the outstanding Action and not by Lanier, then there would be no reason to have display 4 on as it could not display a superimposed image. Also, column 5, lines 10-20 of Lanier deal with image margins and image compression, not the claimed “state in which a prescribed period has not elapsed after the startup of the projection display apparatus.” Once again, the lack of any explanation of how Lanier is being interpreted in a reasonable manner to teach these claim features conflicts with the requirement of 37 CFR §1.104(c)(2) for a clear explanation as well as with the requirements of In re Rijckaert, supra. Accordingly, this rejection of independent Claims 11, 20, and 23 is traversed. ✕

As Claims 12-16 depend ultimately from Claim 11, and as JP 4-205476 cures none of the deficiencies noted above as to Orita and Lanier, the rejections applied to Claims 12-16 are traversed for the reasons stated above.

In addition, the rejections applied as to Claims 12-16 are traversed because each of these claims adds features to parent Claim 11 that are also not reasonably

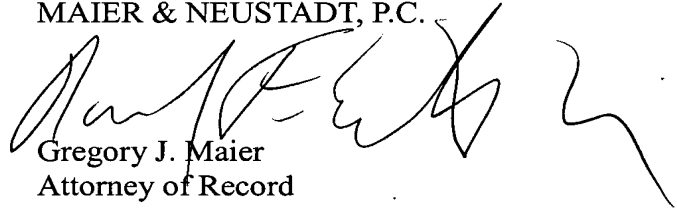
taught or fairly suggested by any of Orita and/or Lanier and/or JPO4-205476 whether they are considered alone or together in any proper reference combination. Thus, the rejections of Claims 12-16 are further traversed for this reason as well.

With regard to independent Claims 18, 21, and 24, as well as to dependent Claim 16, it is again noted that each of these claims recite and require judging if a display apparatus is in a specific operating condition or not and a specific image is displayed when the display apparatus is detected as being in the specific operating condition. As further noted above, the specific operating condition includes at least one of a state in which no image signal is being given to the projection display apparatus and a state in which a prescribed period has not elapsed after the startup of the projection display apparatus. Accordingly, the rejection of Claims 16, 18, 21, and 24, is traversed for this reason as well.

Accordingly, as no other objections or rejections remain outstanding, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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